IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify pursuant to 37 C.F.R. § 1.8(a)(1) that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

MAIL STOP AMENDMENT
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

on 30 January, 2006.

Donald E. Schreiber

Dated: 30 January, 2006

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Serial No. : 09/168,644 Confirmation No. 2742
Applicant : Mark D. Conover
Filed : October 8, 1998
Title : ENCODING A STILL IMAGE INTO COMPRESSED VIDEO
TC/A.U. : 2613
Examiner : Richard J. Lee

Docket No. : 2134
Customer No.: 23320

MAIL STOP AMENDMENT
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir:

This communication responds to an Office Action dated September 30, 2005, for the patent application identified above.

Introductory Remarks

The September 30, 2005, Office Action rejects pending independent claim 1 under 35 U.S.C. § 102(e) as being anticipated by United States Patent no. 6,324,217 entitled "Method and Apparatus for Producing an Information Stream Having Still Images" which issued November 27, 2001, on an application filed July 8, 1998, by Donald F. Gordon ("the Gordon patent"). **The rejection of pending independent claim 1 appearing in the September 30, 2005, Office Action is identical to a rejection of independent claim 1 appearing in a prior Office Action dated February 12, 2002, i.e. more than forty-three (43) months (more than three and one-half (3-½) years), before the mailing date of the presently outstanding Office Action.**

A July 12, 2002, declaration under 35 U.S.C. § 1.131 by the inventor Mark D. Conover included in a response to the February 12, 2002, Office Action that was received by the United States Patent and Trademark Office ("USPTO") on July 19, 2002, traverses the rejection of independent claim 1 based upon the Gordon patent.

Since the Gordon patent was initially cited in the February 12, 2002, Office Action's rejection of pending independent claim 1, no Office Action or response thereto or no brief filed in Applicant's successful appeal of this application's claim rejections respectively appearing in the October 11, 2002 and March 18,

2003, Office Actions mentions the Gordon patent.[1] **The complete silence regarding the Gordon patent in two (2) Office Actions subsequent to the July 19, 2002, response to the February 12, 2002, Office Action throughout an interval of more than three and one-half (3-½) years irrefutably establishes that a conclusion had been reached that the July 12, 2002, declaration by Mark D. Conover successfully traverses the rejection of pending independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent.**[2]

Applicant respectfully submits that the failure to mention the Gordon patent for more than three and one-half (3-½) years either in the October 11, 2002, in the March 18, 2003, Office Actions or during Applicant's successful appeal of claim rejections appearing in those two (2) Office Actions:

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[1] The question of sufficiency of affidavits or declarations under 37 C.F.R. § 1.131 should be reviewed and decided by a primary examiner. (Manual of Patent Examining Procedure ("MPEP") Eighth Edition Rev. 4, October 2005, pp. 700-262, § 715.08)

[2] If it had been concluded that the July 12, 2002, declaration of Mark D. Conover under 37 C.F.R. § 1.131 failed to traverse the rejection of independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent, **either the October 11, 2002, and/or March 18, 2003, Office Actions could have maintained that rejection of independent claim 1 under 35 U.S.C. § 102(e) in addition to other bases for claim rejections appearing in those two (2) subsequent Office Actions**.

1. **is res judicata on the issue of rejecting pending independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent**; and

2. **estops rejection of independent claim 1 under 35 U.S.C. § 102(e) based upon that reference now**.

In addition the existence of the preceding estoppel that now bars rejecting independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent, for reasons explained in greater detail below the decision that the July 12, 2002, Conover declaration traverses a rejection of claims based upon the Gordon patent is sound and proper because:

1. claims of the Gordon patent differ patentably from the subject matter encompassed by pending independent claim 1; and

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2. to the extent that the Gordon patent and the present application might possibly **claim** the same invention, controlling precedent bars rejecting independent claim 1 under 35 U.S.C. § 102(e) because the Gordon patent lacks an enabling disclosure[3] of the subject matter encompassed by pending independent claim 1, i.e. pre-defined data structure NULL frames.

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[3] "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, **the stated test is whether a reference contains an 'enabling disclosure'**... ." MPEP Eighth Edition Rev. 4, October 2005, pp. 2100-64 - 2100-65, § 2121.01, citing In re Hoeksema, 399 F.2d 269, ____, 158 USPQ 596, ____ (CCPA 1968). (Emphasis supplied.)

The **disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter**; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. MPEP supra citing Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). (Emphasis supplied.)

AMENDMENTS

There are no **Amendments to the Specification.**

There are no **Amendments to the Claims.**

There are **Amendments to the Drawings.**

Remarks/Arguments begin on page 7 of this Response.